

Please amend Figs. 2 and 6 as indicated in red in the attached marked up copies of such Figs.

**REMARKS**

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment the Applicants have cancelled claims 1-22 and added claims 23-44. Applicants have also amended the specification to overcome the Examiner's objection thereto. Applicants are enclosing marked up copies of the original specification, as required by rule 121.

**1. Objection of the Drawings**

The Examiner has objected to the drawings as including the following reference signs not mentioned in the specification "38" in Fig. 1, "48" in Figs. 2, 3, and "56" in Fig. 5. Applicant has amended the specification to include reference numerals "38" and "56". It should be noted that although the numerical references were inadvertently omitted, the elements themselves were disclosed in the specification. No new matter has been added. As to

reference numeral “48”, Applicant respectfully submit that it is mentioned on pages 15 and 18 of the specification.

The Examiner has also objected that the text boxes in Figs. 2 and 6 do not contain any text. Applicant has amended these Figures to overcome the Examiner’s objection. Accordingly, Applicant respectfully requests withdrawal of the objection to the drawings.

A letter to draftsperson including the amended drawings are attached herewith.

## **2. Objection to the Specification**

The Examiner has objected to the Abstract and specific informalities within the specification. The Applicant has amended the Abstract and the Specification to overcome the Examiner’s objection. The Examiner has also indicated that “4” in Fig. 1 does not appear to point to a voltage source. Applicant respectfully disagrees. The specification, on page 14, line 17, states that “the complete feed voltage of the two accumulator cells is 2.4 volts.” “4” in Fig. 1 points to the two accumulator cells 29. Thus, “4” is a voltage source.

Based on the above, Applicant requests withdrawal of the objection to the specification.

**3. Rejection of Claims 1-13 under 35 U.S.C. 112**

The Examiner has rejected claims 1-22 under 35 U.S.C. 112, second paragraph, as being indefinite. Applicant has cancelled claims 1-22 and replaced such claims with claims 23-44 to overcome the rejection. Accordingly, Applicant respectfully requests withdrawal of the rejection to this claim.

**4. Rejection of Claims 1-3 under 35 U.S.C. 102**

The Examiner has rejected claims 1-3, under 35 U.S.C. 102, as being unpatentable over U.S. Patent No. 5,662,612 to Niehoff. Applicant respectfully disagrees.

Niehoff teaches a computer-controlled injector comprising a console 30, powerhead 40 and powerpack 50. The powerpack 50 is connected to the console 30 and powerhead 40 by standard communication cables. Signals carried on these cables are interfaced to circuitry inside of the powerhead 40,

console 30 and powerhead 40 in the manner described in col. 4, ln. 25 through col. 5, ln. 56. This stationary system is only able to operate if the console 30, powerhead 40 and powerpack 50 are connected.

In particular, the powerhead 40 includes push buttons for direct movement control of the syringe plunger. The operator must press one of the buttons on keypad 34 of the console 30 to start the pre-programmed sequence or injection protocol. The operation of the system is directly controlled by console 30.

In contradistinction, the electronic hand metering device, according to the invention, is able to work completely independent of an external computer. The computer and hand metering device must only be temporarily connected via the data interfaces to change the parameters, routines, programs respectively programming parts stored in the non-volatile write-read memory. After this data, the electronic hand metering may again work independently from the computer based on the actual data.

A rejection based on 35 U.S.C. §102, as in the present case, requires that the cited reference disclose each and every element covered by the claim.

Electro Medical Systems S.A. v. Cooper Life Sciences Inc., 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q.2d 1766, 1767-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The Federal Circuit has mandated that 35 U.S.C. §102 requires no less than "complete anticipation . . . [a]nticipation requires that presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros. 2 U.S.P.Q. 2d at 1053.

Niehoff fails to disclose every element of the claims. Moreover, the examiner is impermissibly using hindsight gleamed from the Applicant's claimed invention to reconstruct the claimed invention from Niehoff . It is unclear even with hindsight how the Niehoff patent leads to the claimed invention.

In view of the above, it is respectfully submitted that Niehoff does not disclose, teach or otherwise suggest the present invention, as defined by independent claims 1-3 . In view of the above, it is respectfully submitted that such claims are patentably distinct over Niehoff . Accordingly, Applicant

respectfully requests withdrawal of the rejection to such claims under 35 U.S.C. 102.

**5. Rejection of Claims 4-6, 8, 10-13, 21 and 22 under 35 U.S.C. 103**

The Examiner has rejected claims 4-6, 8, 10-13, 21 and 22, under 35 U.S.C. 103, as being obvious in view of U.S. Patent No. 5,662,612 to Niehoff. Applicant respectfully disagrees. For the reasons discussed above with regard to claims 1-3 and further in view of the remarks set forth below the Applicant respectfully submits that claims 4-6, 8, 10-13, 21 and 22 are patentable over Niehoff.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

The In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”. The prior art must be viewed “without reading into that art Appellant’s teachings” and the teachings of the prior art should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis

in the original text) make the invention as a whole, obvious." In re Sponnoble, 160 U.S.P.Q. 237, 243 (CPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue.

Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



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Dated: January 22, 2003  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on January 22, 2003.



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